

REMARKS

This response is intended to be fully responsive to the Office Action having a mailing date of March 3, 2006, wherein claims 28, 30 and 32-34 are rejected. No claims have been amended in this response.

No new matter has been added by this response. Claims 28, 30 and 32-34 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Avitsur et al. (6,201,854) in view of Ubowski (6,389,125).

For at least the reasons set forth below, all pending claims are believed to be in condition for allowance. Further, Applicants believe that there are also reasons other than those set forth below why the pending claims are patentable, and reserve the right to set forth those reasons, and to argue for the patentability of the dependent claims not explicitly addressed herein, in future papers.

Claim Rejections – 35 U.S.C. § 103

Claims 28, 30 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Avitsur et al. (6,201,854) in view of Ubowski (6,389,125). Applicants respectfully traverse this rejection.

Claims 28-31

Independent claim 28 recites an automated telephone test apparatus configured to, among other things,

receive DTMF signals indicative of a telephone number corresponding to said telephone line from said line identification facility at said central office to which said dialing signals were applied;

decode said received DTMF signals;

retrieve said stored assignment data from said memory;

compare said telephone number indicated by said retrieved assignment data with said telephone number indicated by said received and decoded DTMF signal; and

indicate whether said telephone line tested was the intended subject of the test assignment.

Thus, claim 28 recites an automated telephone test apparatus that performs the steps recited above.

In contrast, Avitsur et al. teaches a system and method for telephone number verification and identification that depends upon human interpretation of text and audible information generated at the central office. To facilitate the identification and/or verification of a telephone line being tested, Avitsur et al. teaches that the system receives a voice announcement from the central office to be played on the system. It is preferred that the voice announcement includes the telephone number of the telephone line being tested and is converted to text for helping in determining the contents of the voice message. (See Col. 6, lns. 14-44) It is appreciated that the voice announcements and text information taught by Avitsur et al. are generally understood to be interpreted by the human user of the system. *Id.* Ubowski does not cure Avitsur's shortcoming in this regard.

Applicants' specification describes and distinguishes prior art systems, like that cited by the Examiner, requiring human intervention:

Referring again to Fig. 3B, the apparatus receives the DTMF signals transmitted from the central office (block 110), and decodes the DTMF signals to produce data which indicates the telephone number corresponding to the telephone line under test. There follows block 112, at which the apparatus retrieves from memory 20 (Fig. 3) data which identifies the telephone number of the telephone line which is the intended subject of the work assignment (e.g., the telephone line on which trouble was reported). It will be understood that the work assignment data, including the number of the line to be tested, had previously been stored before commencing the test procedure. The apparatus then compares the telephone number data retrieved from memory with the telephone number data obtained by decoding the DTMF signals from the central office, to confirm that the line actually tested was the one intended to be tested according to the work assignment.

This machine-to-machine work assignment confirmation procedure represents an advance over the prior art practice, in which the test technician dialed up the central office

telephone line i.d. facility, and then listened to an audible verbal response, generated via speech synthesis by the central office equipment, which stated the line number of the tested line. The prior practice required the technician to match the number given by the machine-generated speech with the work assignment data specifying the line intended to be tested. The machine-to-machine confirmation procedure of Figs. 3B and 3C relieves the technician of the effort of carrying out line i.d. confirmation, while enabling the test apparatus to automatically store data confirming that the line tested was in fact the line which was the intended subject of the test assignment. (See page 9, lns. 1-33 of the specification) (Emphasis added)

Therefore, Avitsur et al. does not teach or suggest, either standing alone or in combination with Ubowski, the limitations as recited in claim 28. Accordingly, independent claim 28 and dependent claim 29 are distinguishable over the cited prior art.

Independent claim 30 is a method claim that substantively recites the steps performed by the "apparatus" in claim 28 (set forth hereinabove). Thus, for the same reasons that claims 28 and 29 are allowable, independent claim 30 and dependent claim 31 are allowable.

For the reasons stated herein, Applicants respectfully request that the Examiner withdraw his rejection of claims 28 and 30.

Claims 32-34

Independent claim 32 recites the following.

A method of identifying a telephone line, comprising the steps of:

receiving at a central office dialing signals transmitted via a telephone line connected to the central office;

in response to receiving said dialing signals, generating at said central office DTMF signals indicative of a telephone number which corresponds to said telephone line on which said dialing signals were transmitted, and

transmitting on said telephone line said DTMF signals generated at said central office. (Emphasis added.)

As with claims 28-31, claim 32 recites steps that are performed to test a telephone line automatically, without human interpretation or intervention. As set forth above, neither Avitsur et al. nor Ubowski teaches such a system. For this reason, Applicants submit that claims 32-34 are allowable over the cited prior art.

Improper Combination of Avitsur and Ubowski

MPEP Section 2143 sets forth the basic requirements for the Patent and Trademark Office to establish *prima facie* obviousness as follows: "To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." The initial burden in presenting a *prima facie* case of obviousness is on the examiner. *In re Oetiker*, 977 F.2d 1443, 1443 (Fed. Cir. 1992). Here, the Examiner has failed to 1) show a combination of art that meets all claim limitations, and 2) show a motivation to combine the teachings of the references.

Obviousness cannot be established by combining prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. When obviousness is based on the teachings of multiple prior art references, the Examiner must also establish some "suggestion, teaching, or motivation" that would have lead a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed. *See Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1359-60 (Fed. Cir. 1999); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1572 (Fed. Cir. 1996). "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for showing of the teaching or motivation to combine prior art references." *Dembiczak*, 175 F.3d at 999; see also *Ruiz*, 234 F.3d at 665 (explaining that the temptation to engage in impermissible hindsight is especially strong with seemingly simple mechanical inventions). This is because "[c]ombining prior art references

without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.” *Dembiczak*, 175 F.3d at 999. “Therefore, we have consistently held that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed.” *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371 (Fed.Cir. 2000).

Avitsur et al. teaches a testing environment and a method for telephone number identification and/or verification. On pages 3, 4 and 5 of the Office Action, the Examiner admits that Avitsur et al. does not teach an automated telephone test apparatus that includes a DTMF decoder to decode the received line number data signals (DTMF signals) received from the central office. Avitsur et al. teaches no more than receiving a voice announcement from a central office switch that includes the telephone number of the telephone line to be tested wherein the voice announcement may be converted to text to determine the contents of the message. (See col. 6, lns. 14-17.) Avitsur et al. does not teach or suggest generating DTMF signals at the central office that are indicative of a telephone number of the telephone line to be tested, much less does Avitsur et al. teach or suggest thereafter transmitting those signals on the tested telephone line.

Ubowski, which is alleged to compensate for the deficiencies of Avitsur et al., teaches a telephone system wherein a plurality of telephone devices are capable of receiving call related telephone information, but only one of the devices is designated as a master device responsible for acknowledging receipt of call related information to the central office, and for controlling transfer of the received data to and between each of the other devices over a common telephone line. (See col. 3, lns. 44-53) Although Ubowski discloses using DTMF signaling to transfer information between the master and slave devices, it does not teach or suggest using DTMF signaling from a central office to identify a telephone line in response to receiving dialing signals on that telephone line at the central office. Accordingly, even if the alleged combination of Avitsur et al. and Ubowski included using DTMF signaling from a central office to identify a telephone line in response to receiving dialing signals on that telephone line at the central office, which it does not, Applicants submit that there is no motivation to combine the teachings of the prior art of record.

Further, Applicants submit that the Examiner is improperly using Ubowski as a basis to form an obviousness rejection because it is non-analogous art. Two criteria are used for

determining analogous art: 1) whether the art is from the same field of endeavor, regardless of the problem addressed; and 2) if the reference is not within the field of the inventor's endeavor, whether it is still reasonably pertinent to the particular problems with which the inventor is involved. In re Oetiker, 977 F.2d 1443, 1443 (Fed. Cir. 1992).

Applicants' field of endeavor is related to portable apparatus for use in testing telephone lines from subscriber locations. Ubowski's field of endeavor relates to systems for use in facilitating data communications between telephones that share a common telephone line. Applicants endeavor to reduce the level of skill required by a technician for performing troubleshooting procedures on a telephone line from a subscriber's location. Ubowski seeks to provide a telephone system that is capable of sharing call related information and synchronizing data between multiple telephone devices within a home. Clearly, Ubowski's teachings related to a system for facilitating communications between telephones that share a common telephone line are not pertinent to Applicants' apparatus related to providing a device that is capable of performing troubleshooting procedures on a telephone line from a subscriber's location.

Significantly, the Office Action provides no motivation from any prior art to combine Avitsur et al. and Ubowski, and, indeed, no such motivation was present. Therefore, the section 103 rejection should be withdrawn for either of the three independent reasons that 1) the combination of the prior art of record does not teach all of the claims limitations, 2) there is no suggestion, teaching, or motivation to combine the teachings of the prior art of record, and 3) Ubowski is non-analogous art in view of Applicants' apparatus and is being improperly used to form the basis of an obviousness rejection. Thus, the cited references do not provide the basis for an obviousness rejection. Accordingly, each of the claims 28, 30 and 32-34 is in condition for allowance. Applicants respectfully request that this rejection be withdrawn and that all claims be passed to issue.

CONCLUSION

All rejections have been addressed. In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to

Deposit Account 07-2347. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Respectfully submitted,

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By



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CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8(a))

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Dated: May 3, 2006

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(Christian R. Andersen)